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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/263,311	03/08/1999	JOHN J. KORMAN		1666

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EXAMINER

SINGH, RAMNANDAN P

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/263,311

Applicant(s)

KORMAN ET AL.

Examiner

Ramnandan Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 25 is/are rejected.
- 7) ☒ Claim(s) 5-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the finding of new art, the final rejection dated April 13, 2005 is withdrawn, prosecution is reopened, as new grounds of rejection are made.

2. **Status of Claims**

Claims 1-2 are cancelled.

New Claim 25 is added.

Claims 3-25 are pending.

Response to Amendment

3. The amendment filed on Oct. 12, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has added method claim # 25. Since the disclosure does not support the method claim, this is considered NEW MATTER [See MPEP 2163.06].

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5 Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25 recites "A method for connecting a customer with any of a plurality of telecommunications service providers," in lines 1-14. The disclosure does not support the method claim.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claim 25 recites the limitation "A method for connecting a customer with any of a plurality of telecommunications service providers," in lines 1-14. Therefore, the method comprising steps to execute the process must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 25 is objected to because of the following informalities:

Claim 25 recites the limitation, " providing a terminal block having" in line 4. The term "providing" is not a process [See MPEP 2112.02].

Appropriate correction is required.

Double Patenting

8. ANALYSIS:

To demonstrate that the instant application S/N: 09/263,311 and U.S. patent No. 6,823,064 B1 are claiming common subject matter, a brief analysis is presented below:

(i) Claim 3 of the Instant Application: A terminal block for connecting a customer with any of telecommunications service providers, the block including:

a first connection mechanism which, when not disabled, connects the customer to a service provider;

a second connection mechanism which, when not disabled, connects the customer to a second service provider;

a disabling connection mechanism for disabling either the first connection mechanism or the second connection mechanism;

wherein the first and second connection mechanisms each include normally-closed contacts, and the disabling mechanism includes one or more insulating plugs into at least one of the normally-closed contacts, so as to disable the first connection mechanism or the second connection mechanism or both the first and the second connection mechanisms.

(ii) Claim 1 of U.S. Patent No. 6,823,064 B1: A terminal block for connecting a customer with any of a plurality of telecommunications service providers, the block including:

a first connection mechanism which, when enabled, connects a customer to a first service provider;

a second connection mechanism which, when enabled, connects the customer to a second service provider, and

an enabling mechanism for enabling either the first connection mechanism or the second connection mechanism;

and wherein the first and second connection mechanisms each include normally-open contacts, and the enabling mechanism includes one or more electrically conductive plugs insertable into at least one of the normally-open contacts, so as to provide electrical conductivity across the normally open contacts of the first connection mechanism or the second connection mechanism or both the first and the second connection mechanisms.

(iii) Comparing claim 3 of the instant application with claim 1 of U.S. Patent No. 6,823,064 B1, it is obvious that the wording of claim 3 containing "when not disabled" is equivalent to the wording of claim 1 containing "when enabled". Thus, claim 3 of the instant application and claim 1 of U.S. Patent No. 6,891,809 B1 claim a common invention.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 3 of the instant application is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U. S. Patent No. US 6,823, 064 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U. S. Patent No. US 6,891,809 B1 encompasses all the limitations of claim 3 of the instant application. Similarly, claim 2 of U. S. Patent No. US 6,891,809 B1 encompasses all the limitations of claim 4 of the instant application.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 3, 4 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen [US 6,160,880] in view of Admitted Prior Art (APA) [Applicant's Fig. 1].

Regarding claim 3, Allen teaches a terminal block (40) for connecting a customer (customer premises) with any of telecommunications service providers (new and old providers), as shown in Fig. 3, the block including (i.e. providing):

a first connection mechanism (76) which, when not disabled, connects the customer to a service provider;

a second connection mechanism (74) which, when not disabled, connects the customer to a second service provider;

a disabling connection mechanism (70) for disabling either the first connection mechanism or the second connection mechanism;

wherein the first and second connection mechanisms each include normally-closed contacts (76, 74), and the customer's service provider is changed without inserting or removing wires from the terminal [Fig. 3; col. 7, lines 1-40].

Allen does not teach using disabling mechanisms in the form of insulating plugs to disable the first connection mechanism or the second connection mechanism or both the first and the second connection mechanisms.

The APA teaches using disabling mechanism in the form of insulating plugs insertable into the normally-closed contacts for a single service provider so as to disable

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the connection mechanism [Applicant's Fig. 1; Specification, Pages 2-3]. Although this stand-alone connection mechanism (100) is for connecting a customer to a single service provider, this is nevertheless a teaching to one of ordinary skill in the art to apply the identical connection mechanism to connect the same customer to a second service provider.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of the APA with Allen in order to facilitate disabling either or both service providers of Allen as an alternate method [Allen; col. 8, lines 18-21].

Claim 4 is essentially similar to claim 3 except for the fact that the block includes a plurality of first connection mechanisms and a plurality of second connection mechanisms. Allen, however, does not teach using a plurality of first connection mechanisms and a plurality of second connection mechanisms. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to expand the Allen system so that it can be used with a plurality of first connection mechanisms and a plurality of second connection mechanisms in order to accommodate the required number of connection mechanisms for the Allen system subject to circuit, system and design constraints.

Claim 25 is essentially similar to claim 3 and is rejected for the reasons stated above.

Allowable Subject Matter

13. Claims 5-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 is objected because it identifies the uniquely distinct feature of the connection structure between the first connection mechanism and the second connection mechanism shown in Fig. 2 of the applicant's drawings. Claims 6-24 are also objected because they are dependent from claim 5.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Arnett et al [US 6,078,661] teach plugs (25, 27) in the form of removable conductive plugs which are insertable into any of the normally-open contacts (jacks 24, 26) such that , upon insertions, electrical continuity between the normally-open contacts is provided [Figs. 2, 5; col. 6, lines 13-46]; and

(ii) Wilson et al [US 5,964,609] teach connector units 32 and 33as illustrated in Fig. 19 [col. 15, lines 41-63].

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2646



SINH TRAN
SUPERVISORY PATENT EXAMINER